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EXAMINER

SALTARELLI, DOMINIC D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2611

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/521,176

Applicant(s)

OZAWA, TOSHIRO

Examiner

Dominic D Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:  
Paragraph 11, line 5, "isimproved" should be changed to --is improved--.  
Appropriate correction is required.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: Claim 1, line 4 reads "said distribution request" and should read --a distribution request--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 11, 21, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (5,721,829) [Dunn].

Regarding claim 1, Dunn discloses a program distribution system (fig. 1, col. 2, lines 40-44) comprising:

A distributable program storing unit (fig. 1, program storage 42) operable to store a plurality of distributable programs (col. 3, lines 46-51);

A distribution controller (fig. 1, media server 40) operable to receive a distribution request (STB message, col. 5, lines 29-34), and if a selected program corresponding to said distribution request has been stored in said distributable program storing unit (descriptor is provided specifically for retrieval of programs, col. 5, lines 35-37), to read out said selected program from said distributable program storing unit (col. 3, line 64 – col. 4 line 7 and col. 5, lines 36-39);

A receiver (fig. 1, STB 26) operable to transmit a request for distribution of one of said distributable programs (col. 3, lines 7-20 and col. 5, lines 25-34); and

A distributor (fig. 1, video content playing unit 48) operable to distribute said selected program to said receiver (col. 4, lines 37-46).

Regarding claim 11, Dunn discloses a method of distributing a selected program to a receiver (col. 1, lines 63-67), comprising:

Transmitting a distribution request (STB message, col. 5, lines 29-34) describing said selected program (col. 5, lines 25-41) from said receiver (fig. 1, STB 26) to a transmitter (fig. 1, headend 22);

Comparing said selected program (col. 5, lines 29-35) with a plurality of distributable programs (col. 3, lines 52-55 and col. 5, lines 37-39) stored in a distributable program storing unit (fig. 1, program storage 42);

Reading out said selected program from said distributable program storing unit (col. 3, line 64 – col. 4 line 7 and col. 5, lines 36-39) if said selected program

is one of said plurality of distributable programs (descriptor is provided specifically for retrieval of programs, col. 5, lines 35-37); and

Distributing said selected program to said receiver (col. 5, lines 39-41).

Regarding claim 21, Dunn discloses a transmitter (fig. 1, headend 22) for distributing a selected program (col. 5, lines 25-41) described in a distribution request (fig. 3, order button 86) transmitted from a receiver (fig. 1, STB 26), comprising:

A distributable program storing unit operable (fig. 1, program storage 42) to store a plurality of distributable programs (col. 3, lines 46-51);

A distribution controller (fig. 1, media server 40) operable to read out said selected program from said distributable program storing unit (col. 3, line 64 – col. 4 line 7 and col. 5, lines 36-39) if said selected program (col. 5, lines 25-31) corresponds to a word (descriptor, col. 5, lines 31-37) stored in said distributable program storing unit (col. 5, lines 37-41); and

A distributor (fig. 1, video content playing unit 48) operable to distribute said selected program (col. 4, lines 37-46).

Regarding claim 31, Dunn discloses a receiver (fig. 1, STB 26), comprising:

A transmitter (fig. 2, I/O port 68) operable to transmit a request for the distribution of a specified distributable program (col. 4, lines 53-60 and col. 5, lines 25-41) to a predetermined distribution unit (fig. 1, headend 22); and

A receiver (fig. 2, I/O port 68) operable to receive said specified distributable program from said predetermined distribution unit according to said distribution request (col. 4, lines 56-58).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 6, 8, 12, 16, 18, 22, 26, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Abecassis (US 2001/0041053 A1) and Yurt et al. (5,550,863) [Yurt].

Regarding claims 2, 12, and 22, Dunn discloses the system, method, and transmitter of claims 1, 11, and 21, and additionally discloses each program has a moniker associated with it (col. 3, lines 52-55) and the distribution request can include this moniker (col. 5, lines 31-34), but fails to disclose

Each of said plurality of distributable programs has a title stored in said distributable program storing unit, and

Said distribution controller compares a word described in said distribution request with each of said stored titles, and

Reads out said selected program from said distributable program storing unit when said title of said selected program corresponds to said word.

In an analogous art, Abecassis teaches a video on demand service (paragraph 179) wherein users can access programs using requests that comprise keyword searching and retrieval (paragraph 315), which involves comparing a word within a distribution request with stored descriptions of programs and reading out the selected program when the description corresponds to said word. A keyword search allows users to quickly find a desired distributable program.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Dunn to include comparing a word described in said distribution request with each of said stored monikers, and reading out said selected program from said distributable program storing unit when said moniker of said selected program corresponds to said word, as taught by Abecassis. The reason for doing so is to allow users to quickly find a desired program without linearly incrementing their way through a list.

Dunn and Abecassis fail to disclose the moniker is the program's title.

In an analogous art, Yurt teaches a video on demand service (col. 2, lines 48-59) wherein item names are used to identify items (col. 10, lines 52-56), as

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item names are easier to remember, making user access to these items more intuitive.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Dunn and Abecassis to include the program's title, as taught by Yurt, for the advantage of making the search for a distributable program more intuitive and user friendly.

Regarding claims 6, 16, and 26, Dunn, Abecassis, and Yurt disclose the system, method, and transmitter of claim 2, 12, and 22, but fail to disclose transmitting a notice of correspondence to said receiver.

Yurt further teaches sending a notice of correspondence (fig. 3, confirmation step 3070, col. 13, lines 55-65) upon retrieval of a user requested program, which insures that a user will not choose the wrong program and informs the user of the price of the selection (col. 13 line 66 – col. 14 line 5).

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, and Yurt to include transmitting a notice of correspondence to said receiver, as taught by Yurt, for the advantage of insuring that a user will not choose the wrong program as a result of the search and informs the user of the price of the selection.



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Regarding claims 8, 18, and 28, Dunn, Abecassis, and Yurt disclose the system, method, and transmitter of claim 2, 12, and 22, but fail to disclose said distribution controller reads out said selected program from said distributable program storing unit when said distribution controller receives a notice of confirmation that the user of said receiver agrees to purchase said selected program.

Yurt further teaches reading out a selected program (col. 14, lines 10-12) upon receiving a notice of confirmation from a user (fig. 3, step 3100, col. 14, lines 6-12) that the user agrees to purchase a selected program, insuring that a user will not receive the wrong program (col. 13 line 66 – col. 14 line 5).

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, and Yurt to include reading out said selected program from said distributable program storing unit when said distribution controller receives a notice of confirmation that the user of said receiver agrees to purchase said selected program, as taught by Yurt, for the advantage of insuring that a user will not receive the wrong program as a result of the search.

7. Claims 3, 13, 23, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Sartain et al. (5,914,712) [Sartain].

Regarding claims 3, 13, 23, and 32 Dunn discloses the system, method, transmitter, and receiver of claim 1, 11, 21, and 31, and additionally discloses the

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distribution network can be a satellite distribution network (col. 3, lines 3-6), but fails to disclose said distribution request is converted into an e-mail.

In an analogous art, Sartain teaches a video on demand system (col. 2, lines 38-48) wherein distribution requests are made via e-mail (col. 10, lines 15-20), for the advantage of utilizing the internet for distribution requests.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, transmitter, and receiver disclosed by Dunn to include converting a distribution request into an e-mail, as disclosed by Sartain, for the advantage of utilizing the internet for distribution requests, a commonly utilized backchannel for television distribution systems.

8. Claim 5, 7, 15, 17, 25, 27, 34 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Yurt.

Regarding claims 5, 15, 25 and 34, Dunn discloses the system, method, transmitter, and receiver of claims 1, 11, 21, and 31, but fails to disclose if said selected program is stored in said distributable program storing unit, said distribution controller transmits a notice of correspondence to said receiver.

In an analogous art, Yurt teaches a video on demand service (col. 2, lines 48-59) wherein if a selected program is available, the system transmits a notice of correspondence to the receiver (fig. 3, step 3070, col. 13 lines, 55-60), which insures that a user will not choose the wrong program and informs the user of the price of the selection (col. 13 line 66 – col. 14 line 5).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, transmitter, and receiver disclosed by Dunn to include if said selected program is stored in said distributable program storing unit, said distribution controller transmits a notice of correspondence to said receiver, as taught by Yurt, for the advantage of insuring that a user will not choose the wrong program as a result of the search and informs the user of the price of the selection.

Regarding claims 7, 17, 27, and 35, Dunn discloses the system, method, transmitter, and receiver of claims 1, 11, 21, and 31, but fails to disclose if said selected program is stored in said distributable program storing unit, said distribution controller reads out said selected program from said distributable program storing unit when said distribution controller receives a notice of confirmation that the user of said receiver agrees to purchase said selected program.

In an analogous art, Yurt teaches a video on demand service (col. 2, lines 48-59) wherein if a selected program is available, the system distributes the selected program upon receiving a notice of confirmation that the user of said receiver agrees to purchase said selected program (fig. 3, step 3100, col. 14, lines 6-12), insuring that a user will not receive the wrong program (col. 13 line 66 – col. 14 line 5).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, transmitter, and receiver disclosed by Dunn to include said distribution controller reads out said selected program from said distributable program storing unit when said distribution controller receives a notice of confirmation that the user of said receiver agrees to purchase said selected program if said selected program is stored in said distributable program storing unit, as taught by Yurt, for the advantage of insuring that a user will not receive the wrong program after the initial request.

9. Claims 4, 14, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Abecassis.

Regarding claims 4, 14, 24, and 33, Dunn discloses the system, method, transmitter, and receiver of claims 1, 11, 21, and 31, but fails to disclose said distribution request is a free-style format text described in an arbitrary style of the user of said receiver.

In an analogous art, Abecassis teaches a video on demand service (paragraph 179) wherein users can access programs using requests that comprise keyword searching and retrieval (paragraph 315), allowing users to submit requests in a free-style format text described in an arbitrary style of the user of said receiver. Free-style searching allows users to quickly locate a desired program from a list of programs.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, transmitter, and receiver disclosed by Dunn to include said distribution request is a free-style format text described in an arbitrary style of the user of said receiver, as taught by Abecassis, for the advantage of allowing a user to quickly locate a desired program as opposed to scanning through a list of programs.

10. Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn and Yurt as applied to claims 5, 15, and 25 above, and further in view of Lawler et al. (5,805,763) [Lawler].

Regarding claims 9, 19, and 29, Dunn and Yurt disclose the system, method, and transmitter of claims 5, 15, and 25, but fail to disclose said distribution controller transmits to said receiver a control command to cause a video tape recorder connected to said receiver to record said selected program by attaching said control command to said notice of correspondence.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service can automatically instruct a video tape recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-13) by transmitting a control command (record tag, col. 12, lines 58-61) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said video tape recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25) by attaching said control command

to a notice of correspondence (col. 13, lines 15-18), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn and Yurt to include transmitting to said receiver a control command to cause a video tape recorder connected to said receiver to record said selected program by attaching said control command to said notice of correspondence, as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

11. Claims 10, 20, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn, Abecassis, and Yurt as applied to claims 6, 16, and 26 above, and further in view of Lawler.

Regarding claims 10, 20, and 30, Dunn, Abecassis, and Yurt disclose the system, method, and transmitter of claims 6, 16, and 26, but fail to disclose said distribution controller transmits to said receiver a control command to cause a video tape recorder connected to said receiver to record said selected program by attaching said control command to said notice of correspondence.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service can automatically instruct a video tape recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-

13) by transmitting a control command (record tag, col. 12, lines 58-61) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said video tape recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25) by attaching said control command to a notice of correspondence (col.. 13, lines 15-18), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis, and Yurt to include transmitting to said receiver a control command to cause a video tape recorder connected to said receiver to record said selected program by attaching said control command to said notice of correspondence, as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Lawler.

Regarding claim 36, Dunn discloses the receiver of claim 31, but fails to disclose said receiver receives a control command from said predetermined distribution unit to cause a video tape recorder connected to said receiver to record said specified distributable program.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service can automatically instruct a video tape recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-13) by transmitting a control command (record tag, col. 12, lines 58-61) from a distribution unit (fig. 1, headend 12) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said video tape recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the receiver disclosed by Dunn to include said receiver receives a control command from said predetermined distribution unit to cause a video tape recorder connected to said receiver to record said specified distributable program, as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paolini (5,276,866) discloses a video on demand system which allows users to search for desired titles.



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14. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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## Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D Saltarelli whose telephone number is (703) 305-8660. The examiner can normally be reached on M-F 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli  
Patent Examiner  
Art Unit 2611

DS

  
CHRIS GRANT  
PATENT EXAMINER